

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-13 remain pending in this application. Claims 1 and 6 have been amended hereby to correct matters of form. No new matter has been presented. For the reasons set forth below, Applicant respectfully submits that all of the pending claims are in condition for allowance.

In the Office Action,

- Claims 1-5 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter;
- Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph; and
- Claims 1-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Koppes et al (U.S. 5,926,792, “Koppes”), in view of Van Remortel et al. (U.S. 5,136,502, “Van Remortel”), in view of DiCresce (U.S. 5,991,744).

To the extent these grounds of rejection might again be applied to the claims presently pending in this application, they are respectfully traversed.

Regarding the 35 U.S.C. §101 rejection of the claims, Applicant notes that this ground of rejection appears to be predicated on the recent *In re Bilski* case, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). Applicant notes further that the Supreme Court of the United States has now granted *certiorari* in respect to that case, and that the holding in *In re Bilski*, namely that process claims must pass the strict so-called “machine-or-transformation” test may be overturned, thereby nullifying these types of grounds of rejection. Nevertheless, and in an effort to advance the prosecution of this application at this time, Applicant has amended the claims to recite several “hardware” attributes with respect to which the claimed invention interacts. Specifically, amended claim 1 now recites a method, utilizing a computer system, where the method comprises, among other things,

identifying from human resource data files at least one employee of an employer in said deferred award plan and storing employee related information on a memory device of the computer system.

The newly-added limitations clearly establish that the claimed method is tied to a particular machine (e.g., a “computer,” “data files” and “memory device”), thus placing the claims squarely within the boundaries of what is considered statutory subject matter. Reconsideration and withdrawal of this ground of invention is accordingly respectfully requested.

The claims have also been amended to address the §112, second paragraph, issues raised in the Office Action. Specifically, the claims have been amended to clarify that the recited "asset" is FASB or IASB compliant (and to spell out those acronyms), and also to delete the phrase “under control of said employer” in claim 1 and a similar phrase in claim 6. Reconsideration and withdrawal of the §112 ground of rejection is accordingly respectfully requested.

Regarding the prior art rejection based on a combination of references, Applicant respectfully submits that one of ordinary skill in the art would never be led to the claimed invention having the benefit of the disclosures of Koppes, Van Remortel and/or DiCresce.

While Koppes (the cited primary reference) discloses a relatively sophisticated approach to managing assets, it is acknowledged in the Office Action that Koppes does not disclose anything having to do with allowing an employee to borrow funds accumulated in an insurance policy up to a limit set forth in an endorsement, where the limit reflects a level of compensation according to a deferred compensation plan. For this feature of the present invention, the Office Action relies on DiCresce.

DiCresce discloses a methodology for processing financial data relating to wealth accumulation plans. The portion of the reference relied upon in the Office Action describes how an employee can assign a life insurance contract as collateral for loans of up to 100% of total cash values, less certain offsets. The cited passage of DiCresce also explains how an employee

can use that cash access for his or her investment portfolio to fund health care costs not covered by a high-deductible health insurance policy, as well as life insurance and other post employment benefit (OPEB) costs.

However, the cited passage of DiCresce fails to disclose or to suggest the specific requirements of the claims. Specifically, in DiCresce, the employee borrows funds from a third party, i.e., a financial institution to which the life insurance policy has been assigned. This borrowing from a third party is underscored by the fact that the employee must pay interest on the borrowed funds. See column 13, lines 14-16 of DiCresce. Pending claims 1 and 6, on the other hand, require that the employee be allowed to borrow funds accumulated in "said individual or group life insurance policy." That is, the employee has direct access to funds in the insurance policy. The employee need not borrow from a third party. In other words, in accordance with embodiments of the present invention, the employee borrows from the insurance policy, not from a third party to which the insurance policy has been assigned.

Furthermore, and significantly, there is no mention of any kind in DiCresce of an "endorsement" that operates to limit an amount of funds that can be borrowed by the employee (the limit in DiCresce is defined as 100% of cash value less other items), let alone an endorsement that is tied to a particular deferred compensation plan ("said limit reflecting a level of compensation according to said deferred compensation plan"). Thus, in accordance with embodiments of the present invention, employees might be limited to borrowing less than the cash value of the insurance policy as a result of the specific nature of the endorsement. DiCresce does not contemplate such a structure.

Thus, contrary to the position taken in the Office Action, DiCresce does not cure the admitted deficiency of Koppes as it relates to the amount of funds that can be borrowed by an employee.

Because, for at least the reasons set forth above, DiCresce fails to overcome the acknowledged deficiencies of Koppes relating to the ability of an employee to borrow funds, Applicant respectfully requests that the §103 rejection based on the combination of Koppes, Van Remortel and DiCresce be reconsidered and withdrawn.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicants' undersigned representative at the number listed below.

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Respectfully submitted by:

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